

**Remarks**

This request for reconsideration is in response to the Office Action mailed July 14, 2005. The reconsideration is warranted and necessary because this Office Action lacks the requisite completeness dictated by 37 C.F.R. 1.104(a), resulting in unresolved issues making this case not presently in condition for appeal. These remarks are proper, do not include new matter, are not narrowing in view of a bona fide prior art rejection, do not require the Examiner to perform additional searching, and further substantiate why all claims are in condition for allowance.

**Unresolved Issues**

There are a number of unresolved issues that, without withdrawal of the final rejection, make this case not in condition for appeal. For example, the Office Action of July 14, 2005 is incomplete because the Examiner erroneously did not examine claim 20. There are also numerous claims that are erroneously rejected on the basis of the Examiner's paraphrase of the claimed subject matter instead of the claim language itself. As a result, all claims are finally rejected without an evidentiary basis for the rejection.

**Withdrawal of Claim 20**

Claim 20 was withdrawn by the Examiner as being drawn to a nonelected group. However, the Applicant previously elected and prosecution has continued on the group I claims which includes claim 20. The most recent amendment to claim 20 was in response to the Examiner's rejection for indefiniteness, but it did not substantively change the subject matter of the claim. In any event, the Examiner's apparent moving of claim 20 from the

group I (subcombination) claims to the group II (combination) claims is reversible error because claim 20, as a dependent claim, requires all the features of the group I claim 18 from which it depends. MPEP 806.05(c). Reconsideration of the withdrawal and substantive examination of claim 20 are respectfully requested.

**Rejection Under 35 USC 112, Second Paragraph**

Claim 1 was rejected for lacking an antecedent basis for the claim term "the damper element." The present amendment obviates this rejection by correcting the typographical mistake. Reconsideration and withdrawal of this rejection of claim 1 and the claims depending therefrom are respectfully requested.

Claim 21 was rejected for indefiniteness in that it is allegedly unclear whether the claim was drawn to the group I subcombination claims or the group II combination claims. The present amendment obviates this rejection by more particularly pointing out and distinctly claiming *An isolator assembly that is adapted for....* Reconsideration and withdrawal of this rejection of claim 21 and the claims depending therefrom are respectfully requested.

**Rejection Under 35 USC 102(e)**

Claims 1-8, 10-13, and 18-19 and 21-24 were rejected as being anticipated by U.S. Patent No. 4,690,388 issued to Harrison ("Harrison '388"). This rejection is respectfully traversed.

Claim 1

The Applicant reiterates from its previous Response that Harrison '388 cannot sustain the Section 102 rejection because it does not disclose all the features of claim 1, which recites at least the following:

*a flexible diaphragm with a central membrane portion and an annular portion depending from the membrane, a distal end of the annular portion connected to a rigid base disposing the membrane substantially parallel to the base, the damping element and the base cooperatively defining a sealed chamber....*

(excerpt of amended claim 1, emphasis added)

The Examiner is nonresponsive to Applicant's previous argument that Harrison '388 discloses no *central membrane portion* whatsoever. Instead, the Examiner deflects the argument and obfuscates the issues by basing the anticipatory rejection of Harrison '388 on: "the diaphragm is disposed parallel to the base where it is attached to the load button." (Office Action of 7/14/2005, pg. 3)

The Examiner's basis for the rejection completely ignores the recited claim language. For example, the present embodiments as claimed contemplate the *membrane substantially parallel to the base*. Again, the Applicant has previously argued that Harrison '388 is wholly silent regarding a central membrane portion of a flexible diaphragm. The Examiner has apparently acquiesced to that argument by not rebutting it, but rather by urging that a non-membrane portion of the diaphragm is parallel to the base. The Examiner's assertion that the reference discloses a feature that does not read on the recited claim language is irrelevant.

Accordingly, the Examiner has failed to substantiate how Harrison '388 allegedly anticipates *disposing the membrane substantially parallel to the base* in claim 1, as well as

numerous additional recited features in the dependent claims. This rejection cannot stand in the total absence of an evidentiary basis for it. *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001) The Examiner's claim construction is unreasonable because it ignores both plain meaning and the explicit definition in the specification of the claim language *a flexible diaphragm with a central membrane portion*. *In re Morris*, 43 USPQ2d 1753 (Fed. Cir. 1997). The Examiner's rejection, based on a paraphrase of the recited claim language instead of the claim language itself, fails to satisfy the requirement of completeness with respect to the "patentability of the invention as claimed" that is dictated by 37 C.F.R. 1.104(a). Withdrawal of the final rejection and reconsideration of the present embodiments as claimed by claim 1 and the claims depending therefrom are respectfully requested.

#### Claim 10

The Applicant reiterates from its previous Response that Harrison '388 cannot sustain the Section 102 rejection because it does not disclose or suggest all the recited features of claim 10, which recites at least the following:

*wherein the floating body and fluid isolator damp high frequency vibrations from a machine tool supported thereon....*

(excerpt of claim 10, emphasis added)

The Applicant previously argued that the taut membrane portion of the diaphragm is essential to damping the high frequency vibrations in accordance with the present embodiments as claimed. The Examiner responded: "the air spring/diaphragm will optimally damp a different frequency than [sic] the elastomeric member and therefore one will damp a lower frequency and one will damp a higher frequency." (Office Action of 7/14/2005, pg. 3)

“High frequency vibration” is a term of art known by the skilled artisan to be associated with vibrations in the spectral range associated with objects moving at high speed. Illustrative examples of high frequency vibrations given in the specification and in the previous Response are the rotary motion of the motor, and the attenuation associated with the high-speed acceleration of the servo heads. Where the cited reference is wholly silent regarding its use for damping high frequency vibration, the Examiner posits that in Harrison ‘388 the diaphragm will damp a different frequency than the elastomeric member, and so one will damp a “higher” frequency than the other. Particularly, the Examiner stated: “one will damp a lower frequency and one will damp a higher frequency.”

However, the skilled artisan readily recognizes that the vehicle suspension of Harrison ‘388 contemplates damping only low frequency vibrations. Also, the Examiner’s observation that a particular low frequency vibration occurs at a frequency that is relatively higher than another low frequency vibration does not, in and of itself, make the former a “high frequency vibration” to the skilled artisan. That is, “high frequency vibrations” are commonly defined in relation to the spectral range, not in relation to comparative values.

The Applicant reiterates that the present embodiments as claimed provide a structurally distinct arrangement in view of Harrison ‘388, one that is capable of high frequency attenuation where Harrison ‘388 is inherently incapable of doing so. The Examiner’s claim construction is unreasonable because it ignores both plain meaning and the explicit definition in the specification of the claim language *high frequency vibrations*. *In re Morris*. In extrapolating this unreasonable meaning, the Examiner has failed to substantiate how Harrison ‘388 allegedly anticipates *wherein the floating body and fluid isolator damp high frequency vibrations* in claim 10, as well as numerous other recited

additional features in the dependent claims. This rejection cannot stand in the total absence of an evidentiary basis for it. *In re Zurko*. The Examiner's rejection, based on a paraphrase of the recited claim language instead of the claim language itself ("higher" instead of "high"), fails to satisfy the requirement of completeness with respect to the "patentability of the invention as claimed" that is dictated by 37 C.F.R. 1.104(a). Withdrawal of the final rejection and reconsideration of the present embodiments as claimed by claim 10 and the claims depending therefrom are respectfully requested.

#### Claim 18

The Applicant reiterates from its previous Response that Harrison '388 cannot sustain the Section 102 rejection because it does not disclose or suggest all the recited features of amended claim 18, which recites at least the following:

*damping simultaneously both high frequency and low frequency vibration in a machine tool....*  
(excerpt of claim 18, emphasis added)

As discussed above, and reiterating from Applicant's previous response, Harrison '388 is wholly silent regarding the taut diaphragm membrane that makes the present embodiments capable of damping high frequency vibrations. The Examiner's claim construction is unreasonable because it ignores both plain meaning and the explicit definition in the specification of the claim language high frequency...vibration. *In re Morris*. In extrapolating this unreasonable meaning, the Examiner has failed to substantiate how Harrison '388 allegedly anticipates *damping simultaneously both high frequency and low frequency vibration* in claim 18, as well as numerous additional recited features in the dependent claims. This rejection cannot stand in the total absence of an evidentiary basis for



it. *In re Zurko*. The Examiner's rejection, based on a paraphrase of the recited claim language instead of the claim language itself ("higher" instead of "high"), fails to satisfy the requirement of completeness with respect to the "patentability of the invention as claimed" that is dictated by 37 C.F.R. 1.104(a). Withdrawal of the final rejection and reconsideration of the present embodiments as claimed by claim 18 and the claims depending therefrom are respectfully requested.

#### Claim 21

The Applicant reiterates from its previous Response that Harrison '388 cannot sustain the Section 102 rejection because it does not disclose or suggest all the recited features of amended claim 18, which recites at least the following:

*An isolator assembly that is adapted for damping simultaneously both high frequency and low frequency vibration by supporting a portion of a machine tool on a floating elastomeric member that is pressingly engageable against a flexible planar membrane of a diaphragm.*  
(excerpt of claim 21, emphasis added)

As discussed above, and reiterating from Applicant's previous response, Harrison '388 is wholly silent regarding the planar membrane of a diaphragm that makes the present embodiments capable of damping high frequency vibrations. The Examiner's claim construction is unreasonable because it ignores both plain meaning and the explicit definition in the specification of the claim language *high frequency...vibration* and *flexible planar membrane*. *In re Morris*. In extrapolating this unreasonable meaning, the Examiner has failed to substantiate how Harrison '388 allegedly anticipates *damping simultaneously both high frequency and low frequency vibration* and *a floating elastomeric member that is pressingly engageable against a flexible planar member of a diaphragm* in claim 21, as well

as numerous additional recited features in the dependent claims. This rejection cannot stand in the total absence of an evidentiary basis for it. *In re Zurko*. The Examiner's rejection, based on a paraphrase of the recited claim language instead of the claim language itself ("higher" instead of "high"), fails to satisfy the requirement of completeness with respect to the "patentability of the invention as claimed" that is dictated by 37 C.F.R. 1.104(a). Withdrawal of the final rejection and reconsideration of the present embodiments as claimed by claim 21 and the claims depending therefrom are respectfully requested.

**Rejection Under 35 USC 102(b)**

Claims 1 and 4-9 were rejected as being anticipated by Yanagisawa '303. This rejection is respectfully traversed.

Claim 1 as previously presented is patentable over Yanagisawa '303 which does not disclose *the diaphragm and the base cooperatively defining a sealed chamber*. Rather, Yanagisawa '303 discloses a valve body 401 with a bleed orifice 506 in fluid communication with the diaphragm chamber 312 in order to purposefully not define a sealed chamber. See, for example:

the fitting 504 is formed with a calibrated bleed orifice 506 from 0.1 to 0.3 mm in diameter. When the air pressure in the diaphragm chamber 312 is raised the air will be allowed to escape gradually from the chamber to the atmosphere by way of this calibrated orifice.  
(Yanagisawa '303, col. 4 lines 35-40, emphasis added)

Nevertheless, and solely for the purpose of placing the claim in better condition for allowance or appeal, the Applicant has amended claim 1 to more particularly point out and distinctly claim *the floating body connected to the membrane and moveable therewith within a plane that is parallel to the membrane*. Support for this amendment is found in the



specification at least on page 4 beginning at line 8 which states: "the fluid damping system...which provides similar spring rates in both horizontal and vertical directions...."

Accordingly, the present embodiments as claimed contemplates the floating body having a degree of freedom for moving within the plane defined by the membrane for damping vibrations in that plane. Yanagisawa '303, contrarily, prevents horizontal (or in other words lateral) movement of the load button by constraining the movement of the rod 302 to reciprocation in a direction transverse to the diaphragm 308; see, for example:

Its housing 304 comprises a front half portion 305 including a passage 315 of an adequate size for air passing and for receipt of the rod 302 reciprocatably therethrough....  
(Yanagisawa '303, col. 3 lines 64-67, emphasis added)

Yanagisawa '303 discloses only moving the rod 302 (floating body according to the Examiner's construction) transversely to the plane defined by the diaphragm; it is wholly silent regarding the *floating body connected to the membrane and moveable therewith within a plane that is parallel to the membrane*. Yanagisawa '303 therefore cannot sustain a Section 102 rejection because it fails to identically disclose all the features of the present embodiments as claimed. Withdrawal of the final rejection and reconsideration of the allowability of claim 1 and the claims depending therefrom are respectfully requested.

### Conclusion

This is a complete response to the Office Action mailed July 14, 2005. The Applicant respectfully requests that the Examiner withdraw the final rejection, reconsider the application, and allow all of the pending claims.

The Applicant regrets that the Examiner did not grant the telephone interview requested

in its previous Response, because it likely could have prevented these unresolved issues making this case presently not in condition for appeal. The Applicant has submitted herewith another request for telephone interview to be held after such time the Examiner has fully considered this Amendment but before the next action on the merits if it is determined that all claims are not in condition for allowance. The telephone interview is necessary to clarify the patentable distinction of the present embodiments as claimed over the cited reference as well as all other art of record. The Examiner is invited to contact the below signed Attorney should any questions arise concerning this response or request for interview.

Respectfully submitted,

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